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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,600	03/04/2002	Aleksey Mikhailovich Pinyayev	8878L	6659

27752 7590 10/23/2003

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EXAMINER

MACKEY, JAMES P

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/090,600

Applicant(s)

PINYAYEV ET AL.

Examiner

James Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16 is/are rejected.
- 7) ☒ Claim(s) 17-20 is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9, 14 and 15, drawn to a static mixer article, classified in class 366, subclass 337.
  - II. Claims 10-13, drawn to a process of molding a static mixer article, classified in class 264, subclass 299.
  - III. Claims 16-20, drawn to an apparatus for molding a static mixer article, classified in class 425, subclass 450.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group II and Group I are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product static mixer may be produced by another and materially different process such as using laminar glued elements or such as stamp forming and welding, or the product static mixer may be produced by another and materially different process such as one in which the article is removed from the mold by dissolving the mold, thus avoiding separating mold members by moving them in a direction parallel to protruding members.

3. Inventions of Group II and Group III are related as process and apparatus for its practice.

The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the molding apparatus may be used to practice another and materially different process such

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as reshaping of a solid preform member (e.g., foam or rubber), rather than shaping of a flowable, solidifiable material.

4. Inventions of Group III and Group I are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus such as a single mold member having an appropriately shaped cavity, the single mold member being destroyed by dissolution in order to extricate the molded product.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Larry Huston and Examiner Tony Soohoo on 23 September 2003, a provisional election was made without traverse to prosecute the invention of Group III, claims 16-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Applicant should update the Title to reflect the subject matter of the elected invention.

9. The disclosure is objected to because of the following informalities: the patent number of the copending application cited on page 4 of the specification should be added.

Appropriate correction is required.

10. Claims 16-20 are objected to because of the following informalities: in claim 16, line 1, "a multi-stage ... articles" is grammatically incorrect; and in claim 20, "each each" should be corrected. Also, it is suggested that claim 16 be provided with punctuation to clearly separate the claim sub-paragraphs (for example, a colon after "comprising" on line 2, and a semi-colon after "said axis" on line 6). Appropriate correction is required.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garneau, Sr. (U.S. Patent 4,218,038; Figures 9-11).

Garneau, Sr. discloses a molding apparatus comprising two complementary mold segments 26, 27, the mold segments being juxtaposable to enclose a cavity therebetween, the mold segments including at least one member 33, 34 extending into the cavity at an angle relative to the longitudinal axis of the cavity, the extending members extend in a direction from a proximal end juxtaposed with a wall of its respective mold segment to a distal end contacting a wall of a diametrically opposed mold segment when the mold segments are in a closed position, wherein the molding apparatus has a separation direction which is parallel to the extending members (see col. 3, lines 50-54). Garneau, Sr. does not explicitly teach a transport for opening and closing the mold segments; however, such mold opening/closing means are notoriously well known in the molding art, and it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Garneau, Sr., if not in fact intended, by providing a transport for opening/closing the mold segments in order to more expediently open and close the mold at the beginning and/or end of a molding cycle.

14. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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15. Claim 16 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 9 and 10 of copending Application No. 10/090,601. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

16. Claim 16 is directed to the same invention as that of claims 9 and 10 of commonly assigned copending Application No. 10/090,601. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

17. Claims 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record does not teach or fairly suggest a molding apparatus as claimed, wherein the extending members extend from a proximal end to a distal end offset from the proximal end in the axial direction of the cavity.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

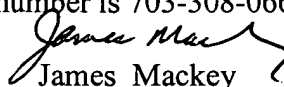
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Allen (U.S. Patent 2,012,800; Figures 10-13) discloses a molding apparatus having two mold segments, each mold segment including extending members connected to the mold segment at a proximal end and extending at an angle to the longitudinal axis of the mold cavity, each extending member being in contact with an extending member of the diametrically opposed mold segment. Natzler (U.S. Patent 2,487,359; Figures 4-6) discloses a molding apparatus having two mold segments, each mold segment including extending members 32-34, 42-44 connected to the mold segment at a proximal end and extending at an angle to the longitudinal axis of the mold cavity, each extending member being in contact with an extending member of the diametrically opposed mold segment. Kohl et al. (U.S. Patent 2,254,295; Figure 4) discloses a molding apparatus having opposed mold segments and transport means for opening/closing the mold segments, each mold segment including an extending member 32 extending at an angle to the longitudinal axis of the mold cavity and being in contact with another member. Miyajima (U.S. Patent 5,114,657), Dunn (U.S. Patent 1,217,860) and Luther (U.S. Patent 5,167,898) each discloses a molding apparatus having extending members extending from mold segments at an angle to the longitudinal axis of the mold cavity, the extending members having distal ends in contact with another member.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 703-308-1195. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 703-308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
James Mackey  
Primary Examiner  
Art Unit 1722

10/20/03